

PATENT

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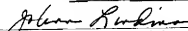
Application No.: 10/762,643 Confirmation No.: 5318
Applicant : Scott Petersen
Filed : January 20, 2004
TC/A.U. : 3731
Examiner : Severson, Ryan J.
Title : RETRIEVABLE BLOOD CLOT FILTER WITH
RETRACTABLE ANCHORING MEMBERS
Docket No. : 1001.1735101
Customer No. : 28075

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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By _____


JoAnn Lindman

Dear Sir:

Appellant respectfully requests a Pre-Appeal Brief Review of the pending application. A Notice of Appeal is filed herewith.

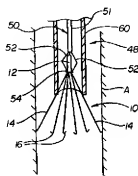
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Appellant has carefully reviewed the Final Office Action of June 19, 2009 and the Advisory Action of September 15, 2009. Currently, claims 1-3, 5-7, 9, 16-26, and 33-36 are pending in the application and have been rejected by the Examiner. Claims 3, 7, 18, 22, 23, and 26 were previously withdrawn. Proposed amendments to correct a typographical error and the dependency of two claims filed in the After Final Amendment are included in this pre-appeal brief and have been entered by the Examiner

for that purpose. Appellant hereby requests a pre-appeal conference and file this pre-appeal conference brief concurrently with a Notice of Appeal. Favorable consideration of the claims is respectfully requested.

Claims 16, 17, 20, 21, 25, and 33-35 were rejected under 35 U.S.C. 103(a) over Ravenscroft et al. (U.S. Patent No. 6,007,558), hereinafter Ravenscroft, in view of Suon et al. (U.S. Patent No. 6,342,062). Additionally, claims 1, 2, 5, 6, 9, and 19 were rejected under 35 U.S.C. 103(a) over Ravenscroft and Suon and further in view of Whitcher et al. (U.S. Patent No. 6,273,901), hereinafter Whitcher. Further, claims 24 and 36 were rejected under 35 U.S.C. 103(a) over Ravenscroft and Suon and further in view of Hebert et al. (U.S. Patent No. 6,482,221), hereinafter Hebert. Appellant respectfully traverses the rejections for at least the reasons that all elements of these claims are not disclosed in this combination of references. As such, these claims are believed to be allowable over these references.

In the final Office Action, the Examiner explicitly acknowledges, "However, Ravenscroft reference does not disclose a retrieval means for retrieving the filter. In the Advisory Action, the Examiner affirms that Ravenscroft was not relied upon to disclose "a middle tubular member configured to engage the hub" as recited in claim 16. Instead, the Examiner used the middle tubular member (60) of Suon to teach the retrieval device in question. Figure 5 of Suon is reproduced below for convenience in the discussion to follow.



The Examiner's position is that member (60) above is CAPABLE of engaging hub 12 even though the middle tubular member of Suon is larger than structure 12, said to be analogous to the hub of Ravenscroft. The Examiner asserts: "there is nothing preventing that hub and the middle tubular member from contacting one another if the

hub is not centered within the tubular member". Appellant notes that catheter (60) as disclosed by Suon is centered about inner tubular shaft (51) for the reason that the hub is drawn into the catheter (60) by the coaxial inner tubular shaft. Elongate members (52) of the inner tubular shaft, also referred to by the Examiner, are disposed about hub (12) and interposed between the hub and the catheter in a manner which precludes contact between the hub and the catheter as the hub enters and is centered, at least to a significant extent, by the radially projecting elongate members of the inner shaft as the catheter is advanced. Were the grasping action of the elongate members and the inner shaft to be omitted, the catheter of Suon does not appear to be capable, by itself, of engaging and retrieving the filter. Accordingly, the catheter (60) does not appear to be capable of contacting hub (12), much less to "engage" the hub. [engage, transitive verb: (of a machine part) to fit into and move together with another part, or cause (something) to fit into and move together] (Cambridge Dictionary of American English)

Even were one to assert that the hub (12) in some sense broadly "fits into" the catheter (60), the hub and catheter move independently as required by the operation of Suon and the catheter does not engage and move together with the hub. As the Supreme Court reaffirmed in *KSR v. Teleflex*, "rejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1395, 1397 (2007) (quoting *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). The Examiner's statement, "It is the Examiner's position that the middle tubular member (60) is CAPABLE of engaging the hub." is such a mere conclusory statement and cannot sustain a rejection on obviousness grounds.

The Examiner's closing statement in the Advisory action indicating that "arms (52) are a part of the elongate inner member (51) and therefore are capable of grasping the apical head" also appears to be conclusory. In any event, mere grasping of the hub (12) by the elongate inner members (52) does not suffice to disengage and retrieve the filter and thus inner member (51) does not provide a retrieval device.

For at least these reasons, Ravenscroft in view of Suon does not appear to provide "a retrieval apparatus for retrieving or repositioning the blood clot filter device within the

blood vessel, the retrieval apparatus including a tubular inner member configured to grasp the apical head, a middle tubular member configured to engage the hub, and an outer sheath for encapsulating the blood clot filter device” as recited in independent claims 1 and 16. The addition of a pad (42A) of Whitcher and/or a braided tubular member (56) of Herbert does not overcome the identified deficiencies of Ravenscroft in view of Suon as applied to independent claims 1 and 16 as required to establish a *prima facie* case of obviousness. Appellant respectfully requests that the rejections be withdrawn.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03)

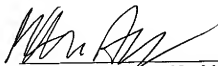
Accordingly, claims 2, 5, 6, 9, 17, 19-21, 24, 25, and 33-36, which depend from nonobvious independent claims 1 and 16 respectively, also are believed to be nonobvious and Applicant respectfully requests that the rejections be withdrawn.

For at least the reasons mentioned above, all of the pending claims are allowable over the cited prior art. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Date:

Oct. 19, 2009



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